



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,467	12/12/2003	Veronique Ferrari	244818US0	8836
22850 7590 10/17/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1619				
NOTIFICATION DATE		DELIVERY MODE		
10/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/733,467

Applicant(s)

FERRARI ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1615

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date 6/30/08 and 7/9/08.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 74,75,77-79,81,83,85,87-91,93,94,96,98,99,101-103,105,107,109,111-115,117,118,120,122,123,125-127,129,131,133,135-139,141,142,144 and 146-153.

Continuation of Disposition of Claims: Claims rejected are 74,75,77-79,81,83,85,87-91,93,94,96,98,99,101-103,105,107,109,111-115,117,118,120,122,123,125-127,129,131,133,135-139,141,142,144 and 146-153.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/08 has been entered.

Receipt is also acknowledged of IDS filed on 6/30/08 and 7/9/08. **Claims 1-73, 76, 80, 82, 84, 86, 92, 95, 97, 100, 104, 106, 108, 110, 116, 119, 121, 124, 128, 130, 132, 134, 140, 143, and 145 are cancelled.**

Claims 74, 75, 77-79, 81, 83, 85, 87-91, 93-94, 96, 98-99, 101-103, 105, 107, 109, 111-115, 117-118, 120, 122-123, 125-127, 129, 131, 133, 135-139, 141-142, 144 and 146-153 are currently pending.

Claim Rejections - 35 USC § 112

1. Claims 74-75, 77-79, 81, 83, 85, 87-91, 93-94, , 96, 98-99, 101-103, 105, 107, 109, 111-115, 117-118, 120, 122-123, 125-127, 129, 131, 133, 135-139, 141-142, 144, and 146-153 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is new matter rejection.

2. There is no support in the specification for the silicone polyamide copolymer formula recited in claim 74 and the species recited in claims 149-153.

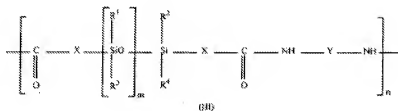
Response to Arguments

Applicant's arguments filed 6/30/08 have been fully considered but they are not persuasive.

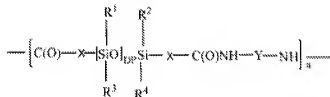
Applicants argue:

“The claimed polymers are specified silicone/amide copolymers. The claimed copolymers are preferred copolymers disclosed in the present specification. For example, the claimed copolymers correspond to formula III (page 20), in which DP (degree of polymerization) or $m = 1-700$, $n = 1$ to 500, X is a linear or branched chain alkylene having 1-30 carbons, and Y is selected from the group consisting of linear or branched chain alkenes having 1-40 carbons, (see, page 22, par. [0051]), and R1, R2, R3 and R4 are the same or different and may be selected from the group consisting of methyl, ethyl, propyl, isopropyl, a siloxane chain, and phenyl. (See, pages 23-24, par. [0055]). Thus, the claimed copolymers of the pending independent claims are described in the present application”.

In response to the above argument, paragraph [0049] describes formula III. See below for formula III.



The formula claimed in claim 74, along with variables and definitions are shown below.



where: (a) DP is between 1 and 700; (b) n is a number selected from the group consisting of 1-500; (c) X is a linear or branched chain alkylene having 1-30 carbons; (d) Y is selected from the group consisting of linear or branched chain alkylenes having 1-40 carbons; (e) R¹, R³, R² and R⁴ are the same or different and may be selected from the group consisting of methyl, ethyl, propyl, isopropyl, a siloxane chain, and phenyl.

Paragraph 451 describes the claimed values along with preferred values. See below for paragraph 51.

[051] In these polyamides of formula (III) or (IV), m is an integer of at least one as defined above, and preferably in the range from 1 to 700, for example, from 15 to 500 and from 15 to 45, including all values and subranges there between; and n is in particular in the range from 1 to 500, for example, from 1 to 100 and from 4 to 25, including all values and subranges there between; X is preferably a linear or branched alkylene chain containing from 1 to 30 carbon atoms and in particular 3 to 10 carbon atoms, and Y is preferably an alkylene chain that is linear or branched or that possibly comprises rings and/or unsaturations, containing from 1 to 40 carbon atoms, including from 1 to 20 carbon atoms and from 2 to 6 carbon atoms, including all values and subranges there between, for example, 6 carbon atoms.

[055] In formulae (III) and (IV), R^1 , R^2 , R^3 and R^4 preferably represent, independently, a linear or branched C_1 to C_{10} alkyl group,

preferably a CH_3 , C_2H_5 , $n-C_3H_7$ or isopropyl group, a polyorganosiloxane chain or a phenyl group optionally substituted with one to three methyl or ethyl groups.

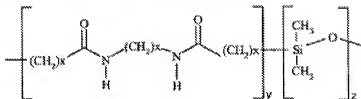
The formula claimed in claim 74 recites specific groups for $R1-R4$ and recites the value for DP (corresponding to m) and n as 1-700 and 1-500. Applicants have carved out a genus which has broader value for n and m and X and Y and yet having preferred specific groups for $R1-R4$. Therefore new matter is deemed proper.

Applicants also argue:

“Regarding the specified copolymers of claims 149-153, these copolymers are the preferred copolymers of the present application (see, for examples, 35-36), and cover such polymers having different degrees of polymerization (DP). (See, for example, examples 31-34 (DP 100), example 21 (DP 45) and example 7 (DP 15)).”

In response to the above argument, claims 149-153 are drawn to species where in the silicone polyamide is “nylon 611/dimethicone copolymer”. Does the same species have different DP values? Additionally applicants attention is drawn to NPL document titled “Dow Corning ® 2-8178 Gellant “ (IDS dated 7/9/08) shows the chemical structure shown below.

Figure 2: DOW CORNING 2-8178 Gellant chemical structure.



What is the value of y , x and z ? How is this species related to formula claimed in claim 74? Additionally examples 31-34 have **DC 2-8179** having DP 100 and examples 35-36 have **DC 2-8178** gellant with no DP value and example 7 has DC 2-8179 with DP value 15 and example 21 does not describe the gellant or the copolymer claimed in claims 149-153 except for DP value. What is the structure of DC 2-8179 gellant and what are values? What is the difference between DC 2-8178 gellant and DC-8179 gellant? The species claimed in claims 149-153 are not drawn to species of claim 74. Therefore new matter rejection is deemed proper.

Regarding common ownership statement with various patents and co-pending applications at page 12 of response, applicants are notified that the common ownership statement is not proper. See MPEP 706.02 (I) (2) under section II. The expression "at the time the invention was made " is missing regarding common ownership statement.

The art unit of the examiner is changed from 1615 to 1619.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619

Application/Control Number: 10/733,467
Art Unit: 1615

Page 8